

REMARKS

Claims 1-33 are currently pending in the subject application and are presently under consideration. Claims 1, 21-25, 28 and 31-32 have been amended and claims 26 and 33 have been cancelled as shown on pp. 2-8 of the Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection of Claim 32

Claim 32 is objected to because of the following informalities: it is dependent on claim 21. The examiner will assume claim 32 is dependent on independent claim 31. Applicants' representative thanks the Examiner for pointing out the typographical error. The error has been corrected in concordance with the Examiner's observations.

II. Rejection of Claims 20 and 31 Under 35 U.S.C §112

Claims 20 and 31 stand rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner objects to the term "parallel listing" as used in the claims. Applicants' representative calls the Examiner's attention to the disclosure of a parallel listing in the specification, "some advertisers may not know which enhancements...obtain the most value for their investment...the service provider...can generate a **plurality of parallel listings, each having different enhancement options**...user responses to the parallel listings can be collected and then reported...**to assist them in choosing the more valuable enhancement options**." (see pg. 11, ln. 24 – pg. 12, ln. 2, emphasis added). One of skill in the art would clearly understand this to mean that the parallel listings differ only in that they each have different enhancement options which are being tested by exposure to end users. Based on the test data, the most optimal form(s) of enhancement can be selected by the advertiser. Applicants' representative asserts that the term "parallel listing" is clearly understandable by one of ordinary skill in the art. Applicants' representative respectfully requests that the Examiner withdraw the rejection of claims 20 and 31 under 35 USC § 112, second paragraph.

Claims 20-25, 28, 31 and 33 stand rejected under 35 U.S.C §112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner objects to the term “subset listing” as used in the claims. Applicants' representative asserts that the term “subset” is well defined as “a set (as of data) that is itself an element of a larger set; *especially*: a mathematical set each of whose elements is also an element of a given set”, (*see* “subset.” *Webster's Third New International Dictionary, Unabridged*. Merriam-Webster, 2002. <http://unabridged.merriam-webster.com> (11 Mar. 2008)). Thus, a “subset listing” (or variants thereof) are sets of listings that are themselves elements of larger set of listings. Applicants' representative asserts that this would be clear to one of ordinary skill in the art. Further, applicants' representative has cancelled claim 33 (thereby obviating the rejection) and amended claims 21-25, 28 and 31 to further clarify the use of the term in the claims. Applicants' representative respectfully requests that the Examiner withdraw the rejection of claims 20-25, 28, 31 under 35 USC § 112, second paragraph.

Claim 28 stands rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner objects to the term “globally” as used in the claim. Applicants' representative calls the Examiner's attention to the disclosure of “globally” in the specification, “**global enhancement** selections can be made for at least a **subset of listings and/or** for substantially **all listings** in some or all markets, for example.”, (*see* pg. 8, ln. 21–22, emphasis added). One of ordinary skill in the art would clearly understand the use of “global” as indicating that enhancement selections are applied to entire groups of listings (*e.g.*, subsets of listings, all listings in some markets, all listings in all markets,...). Thus, it is asserted that “globally” as used in claim 28 is clear to one of ordinary skill in the art. Applicants' representative respectfully requests that the Examiner withdraw the rejection of claim 28 under 35 USC § 112, second paragraph.

III. Rejection of Claim 1 Under 35 U.S.C. §101

Claim 1 stands rejected under 35 U.S.C. §101 because it is not statutory and the term “component” is defined in the specification as “a component may be, but is not limited to being a process running on a processor, a processor, an object, an executable, a thread of execution, a program, and/or computer”. Claim 1 has been amended to add physical structure to the claim. Thus, the claim is not directed to software *per se* as it now explicitly requires computer hardware

for implementation, in accord with the intentions of the applicants originally filed claim. Applicants' representative respectfully requests that the Examiner withdraw the objection to claim 1 under 35 U.S.C. § 101.

IV. Rejection of Claim 33 Under 35 U.S.C. §101

Claim 33 stands rejected under 35 U.S.C. §101 because it is not statutory and data packet is interpreted as data. Data is considered non functional descriptive material and is not given patentable weight. Claim 33 has been cancelled and the rejection is thus obviated.

V. Rejection of Claims 21, 23-25 and 33 Under 35 U.S.C. §102(e)

Claims 21, 23-25 and 33 stand rejected under 35 U.S.C. §102(e) as being anticipated by Rodriguez US Publication 2004/0059720 A1. Applicants' representative respectfully traverses the rejection of claims 21 and 23-25 under 35 USC § 102(e) as being unpatentable over Rodriguez.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

The invention of Rodriguez is generally directed to searching and sorting multimedia and other data. More specifically, Rodriguez allows searches that can be sorted and filtered based on **user** input. “The system displays a selection of views which allow **the searcher** to choose the format of the search results...**the user** may specify the style of the views...**the searcher** then has the option of linking...**the user** also has the ability to search using...**the user** can directly access...**the user** can select the type of search results **the user** wishes to review...”, (see Rodriguez abstract, emphasis added). Further, “the system provides a number of search capabilities...**the user** may specify the style of the views, including the arrangement of the views, provided by the system...**the user** may input search keywords to the system...the system displays a selection of views which allow **the searcher** to choose the format of the search results...**the**

user selects views from **user-customized favorite program files...**”, (see Rodriguez [0023], emphasis added). In fact, Rodriguez does not disclose, either expressly or inherently, any form of enhancement other than sorting and filtering by the user.

Applicants’ disclosed subject matter relates generally to, “visually enhancing **paid inclusion listings** to facilitate offering a clear and substantial value to **paid inclusion advertisers** while retaining ordering rights to keep listings relevant to users”, (see pg. 2, ln 14-18). More specifically, the applicants’ disclosed subject matter allows enhancement of listings **by the paid inclusion advertisers**, and further, is in no way specifically limited to end user sorting and filtering. Value is added to paid inclusion list advertisement placement by allowing the advertiser to emphasize their advertisement listings (e.g., listings of advertisements produced from, for example, a search engine, as compared to the advertisements themselves).

With regard to claim 21, the present subject matter is distinctly different from that of Rodriguez for at least the following reasons. Claim 21 has been amended to more clearly recite this aspect of the disclosed subject matter, “...providing a plurality of **listings including at least one paid inclusion listing** to an end user; modifying at least a subset of the plurality of listings **according to one or more paid inclusion customer selected enhancement options**; and rendering the plurality of listings **based in part upon at least one of the one or more paid inclusion customer selected enhancement options** and end user preferences.” (see claim 21, emphasis added). Rodriguez neither explicitly, nor implicitly, discloses any aspect of enhancement related to the party of the listing and, more importantly, does not disclose any aspect of a ‘paid inclusion listing’ at all.

Additionally, for the same reasons, Applicants submit that claims 23-25 are allowable, as these claims depend from Claim 21. Claim 33 has been canceled as the rejection is obviated. Therefore, based on the above remarks, the applicants’ representative respectfully requests that the Examiner withdraw the rejection of claims 21 and 23-25 under 35 USC § 102(e) as being anticipated by Rodriguez.

VI. Rejection of Claims 1-2, 4, 7-12, 14-15, 19 and 26 Under 35 U.S.C. §103(a)

Claims 1-2, 4, 7-12, 14-15, 19 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Wen US Publication 2001/0047297 A1. Applicants’ representative respectfully traverses the rejection of claims 1, 2,

4, 7,-12, 14, 15, and 19 under 35 USC § 102(e) as being unpatentable over Rodriguez in view of Wen.

The invention of Wen is generally directed to enabling end users to create advertisements that can be marketed by an ad broker system (*see* Wen abstract). Wen states, “the present invention provides a method and an ad brokering system which allows advertisers and publishers to exchange **ad space** for payment wherein an **advertiser is provided the resources to remotely generate Internet ads** that it otherwise could not without technical resources”, (*see* Wen [0010], *emphasis added*). While Wen does discuss user friendly methods of creating advertisements, including selecting and incorporating numerous eye-catching characteristics within the advertisement, Wen never raises or discloses any aspect of enhancing paid inclusion listings. The difference between an advertisement and a listing of a plurality of search results and/or advertisements (*e.g.*, the paid inclusion listing(s) is an element of the set of listed results) is an important distinction between Wen and the instant application.

Thus, in regard to independent claims 1 and 15 of the subject application, Wen does not cure the deficiency of Rodriguez, as discussed *supra*, failing to teach or disclose paid inclusion listing enhancements (claim 1 recites “a selection component that allows a **paid inclusion customer** to select one or more enhancements” and claim 15 recites “with a **paid inclusion customer’s enhancement selections**”, *emphasis added*). Moreover, Wen fails to cure the deficiency of Rodriguez to teach or disclose enhancements to the listings being selectively enhanced by the paid inclusion customer/advertiser. Essentially, Rodriguez teaches user sorting and filtering and Wen teaches a low technical and resource bar to creating advertisements, but neither teaches ‘paid inclusion listing’, nor enhancement of a ‘paid inclusion listing’, nor enhancement of the listing being within the purview of the party paying for the ‘paid inclusion listing’. Clearly, the disclosed subject matter is entirely distinguishable from Rodriguez in view of Wen. Additionally, for the same reasons, Applicants submit that claims 2, 4, 7-12 and 14 are allowable, as these claims depend from claim 1; and claim 19 is allowable, as this claim depends from claim 15. Claim 26 has been canceled and the rejection is obviated. Therefore, based on the above remarks, the applicants’ representative respectfully requests that the Examiner withdraw the rejection of claims 1, 2, 4, 7-12, 14, 15, and 19 under 35 USC § 102(e) as being anticipated by Rodriguez in view of Wen.

VII. Rejection of Claims 3, 5, 13 and 16-18 Under 35 U.S.C. §103(a)

Claims 3, 5, 13 and 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Wen US Publication 2001/0047297 A1, in further view of Petropoulos US Patent 7,047,502 B2. Applicants respectfully disagree for at least the following reason. Independent claim 1, from which claims 3, 5 and 13 depend, and independent claim 15, from which claims 16-18 depend, are believed to be allowable over Rodriguez in view of Wen, as asserted *supra*. Petropoulos does not correct this particular deficiency. The rejection of dependant claims 3, 5, 13 and 16-18 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claims 3, 5, 13 and 16-18 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Wen, in further view of Petropoulos.

VIII. Rejection of Claim 22 Under 35 U.S.C. §103(a)

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Petropoulos US Patent 7,047,502 B2. Applicants respectfully disagree for at least the following reason. Independent claim 12, from which claim 22 depends is believed to be allowable over Rodriguez, as asserted *supra*. Petropoulos does not correct this deficiency. The rejection of dependant claim 22 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claim 22 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Petropoulos.

IX. Rejection of Claim 20 Under 35 U.S.C. §103(a)

Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Wen US Publication 2001/0047297 A1, in further view of Johnson US Publication 2002/0107847 A1. Applicants respectfully disagree for at least the following reason. Independent claim 15, from which claim 20 depends is believed to be allowable over Rodriguez in view of Wen, as asserted *supra*. Johnson does not correct this deficiency. The rejection of dependant claim 20 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claim 20 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Wen, in further view of Johnson.

X. Rejection of Claims 27 and 28 Under 35 U.S.C. §103(a)

Claims 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez in view of Johnson US Publication 2002/0107847 A1. Applicants respectfully disagree for at least the following reason. Independent claim 21, from which claims 27 and 28 depend, is believed to be allowable over Rodriguez, as asserted *supra*. Johnson does not correct this deficiency. The rejection of dependant claims 27 and 28 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claims 27 and 28 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Johnson.

XI. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Wen US Publication 2001/0047297 A1 further in view of Vijayan *et al.* US Patent 6,535,888 B1. Applicants respectfully disagree for at least the following reason. Independent claim 1, from which claim 6 depends, is believed to be allowable over Rodriguez in view of Wen, as asserted *supra*. Vijayan does not cure this deficiency. The rejection of dependant claim 6 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claim 6 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Wen, in further view of Vijayan.

XII. Rejection of Claim 29 Under 35 U.S.C. §103(a)

Claim 29 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Shultz *et al.* 2003/0061211 A1. Applicants respectfully disagree for at least the following reason. Independent claim 21, from which claim 29 depends, is believed to be allowable over Rodriguez, as asserted *supra*. Schultz does not correct this deficiency. The rejection of dependant claims 29 under 35 U.S.C. §103(a) is obviated and the applicants respectfully request that the Examiner withdraw the rejection of claims 29 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Schultz.

XIII. Rejection of Claims 30-32 Under 35 U.S.C. §103(a)

Claim 30-32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Johnson US Publication 2002/0107847 A1 further in view of Petropoulos US Patent 7,047,502 B2. Applicants respectfully disagree for at least the following reason. Independent claim 21, from which claim 30 depends, is believed to be allowable over Rodriguez, as asserted *supra*. Neither Johnson nor Petropoulos correct this deficiency. Thus, the rejection of dependant claims 30 under 35 U.S.C. §103(a) is obviated and the applicants respectfully request that the Examiner withdraw the rejection of claim 30 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Johnson, in further view of Petropoulos.

With regard to claim 31, Rodriguez fails to teach, “...generating a plurality of parallel listings **including at least one paid inclusion listing**” (*see* claim 31, emphasis added), as asserted *supra*. Further, in light of the clarification of the term “parallel listings”, the aspect of “generating a plurality of **parallel listings**” (*see* claim 31, emphasis added), is not taught by Johnson, where Johnson discloses ‘additional enhancement options’ as compared to testing a plurality of the same listing iteratively differing only in the applied enhancement. Moreover, Petropoulos fails to cure these deficiencies.

Additionally, for the same reasons, Applicants submit that claim 32 is allowable, as this claim depends from claim 31. Therefore, based on the above remarks, the applicants’ representative respectfully requests that the Examiner withdraw the rejection of claims 30-32 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Johnson, in further view of Petropoulos.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP514US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731